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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,844	09/08/1999	WILLIAM J. INFOSINO	113589	9186

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EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 02/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/391,844

Applicant(s)

INFOSINO, WILLIAM J.

Examiner

Jared J. Fureman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 12/9/2002 and 1/8/2003 have been entered. Claims 36-42 are pending.

Claim Objections

2. Claim 36 is objected to because of the following informalities: Claim 36, line 5: --account-- should be inserted after "second", in order to maintain consistency with "second account identification data" as recited in lines 2-3. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 36-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Cooper (US 6,308,890 B1).

Cooper teaches a card (3) comprising: a memory (within control circuit 11, see column 3 lines 63-67) for storing a first account identification data and a second account identification data, a control (key pad 9) coupled to the memory for allowing a user to select either the first account identification data or the second account identification data, a re-writeable magnetic storage (programmable magnetic strip 4 or 10) region coupled to the memory, a device (within control circuit 11) for writing either the first or the second account identification data responsive to the control, wherein the control comprises a plurality of touch-sensitive pads (see column 2 lines 51-54), wherein the magnetic storage region comprises a magnetic stripe (see column 2 lines 48-49 and column 4 line 26), wherein the magnetic stripe is configured so as to be compatible with conventional magnetic stripe readers (see column 3 lines 15-26), wherein the first and the second account identification data includes data representing an account number (see figures 1-3, column 1 line 9 - column 2 line 16, column 2 line 46 - column 3 line 36, and column 3 line 60 - column 7 line 4).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Lane (US 5,623,552, cited by applicant).

The teachings of Cooper have been discussed above.

Cooper fails to teach the card further including a fingerprint reader coupled to the memory, the device for writing being responsive to the fingerprint reader, a processor coupled to the fingerprint reader and the memory, the memory storing a fingerprint, the processor being configured to compare a fingerprint read by the fingerprint reader with the fingerprint stored in the memory, the device for writing being responsive to whether the fingerprint read by the fingerprint reader matches the fingerprint stored in memory.

Lane teaches a card (100) comprising: a memory (not labeled, but necessarily present) for storing a first account identification data (predetermined account information), a re-writeable magnetic storage (109) region coupled to the memory, a device (110) for writing the first account identification data responsive to a control (controller 106/authenticator 107), the card further including a fingerprint reader (fingerprint sensor 102) coupled to the memory, the device for writing (110) being responsive to the fingerprint reader, a processor (controller 106/authenticator 107) coupled to the fingerprint reader and a memory (103), the memory (103) storing a fingerprint, the processor being configured to compare a fingerprint read by the fingerprint reader with the fingerprint stored in the memory, the device for writing being responsive to whether the fingerprint read by the fingerprint reader matches the fingerprint stored in memory (the magnetic stripe programmer 110 is responsive to an

authentication signal from the controller 106/authenticator 107, see figures 1A, 1B, 2, column 2 lines 30-35, 54-63, column 5 line 6 - column 6 line 12).

In view of Lane's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the card as taught by Cooper, a fingerprint reader coupled to the memory, the device for writing being responsive to the fingerprint reader, a processor coupled to the fingerprint reader and the memory, the memory storing a fingerprint, the processor being configured to compare a fingerprint read by the fingerprint reader with the fingerprint stored in the memory, the device for writing being responsive to whether the fingerprint read by the fingerprint reader matches the fingerprint stored in memory, in order to provide a self-authenticating card which allows the card itself to authenticate the identity of the user, thereby protecting account information (see column 2 lines 10-35 and 54-63).

Response to Arguments

7. Applicant's arguments with respect to claims 36-42 have been considered but are moot in view of the new ground(s) of rejection. As discussed above, Cooper teaches a card having a programmable magnetic stripe and storing multiple account information and Lane teaches a card having a fingerprint sensor and a programmable magnetic stripe that is responsive to the fingerprint sensor.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zacharias (US 6,494,367 B1), Cooper (US 6,308,890 B1),

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Wallerstein (US 5,955,961), and Maeoka et al (JP 2001-236489 A) all teach cards and/or card systems storing multiple account identification data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jared J. Fureman
Jared J. Fureman
January 30, 2003